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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/487,411      | 06/07/95    | HARVEY               | J 5634.318          |

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LM61/0226

EXAMINER

SAFOUREK, B

ART UNIT

PAPER NUMBER

2732

DATE MAILED: 02/26/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

407,411

|                              |                     |                        |
|------------------------------|---------------------|------------------------|
| <b>Office Action Summary</b> | Application No.     | Applicant(s)           |
|                              | 08/407,411          | Harvey et al           |
|                              | Examiner<br>Safouir | Group Art Unit<br>2732 |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

#### Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

Responsive to communication(s) filed on 0-12-97.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

#### Disposition of Claims

Claim(s) 2-10 and 12-27 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 2-10 and 12-27 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

#### Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of References Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

#### Office Action Summary

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***DETAILED ACTION***

1. This Office Action is responsive to the amendment filed August 12, 1997.

***DOUBLE PATENTING V.S. PATENTS***

2. After reviewing the restriction requirement under 35 USC 121 in US Patent 5,233,654 it is believed that the claims of the instant application are subject to a double patenting analysis against US Patent 4,704,725, 4,965,825, 5,109,414, 5,233,654 and US Patent 5,335,277.

3. In view of further analysis and applicant's arguments, the rejection of the claims in the instant application under double patenting based on the broad analysis of *In re Schneller* as set forth in paragraphs 7-10 of the previous Office Action has been withdrawn.

4. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

*In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 2 - 10 and 12 - 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims \*\*\* of U.S. Patent No.4,704,725, 4,965,825, 5,109,414, 5,233,654 and 5,335,277. Although the conflicting claims are not identical, they are not patentably distinct from each other because; claim 2 differs from claim 59 of 5,233,654 by specifying that the member datum of claim 59 can be any one of several types of financial data; claims 3-6 differ from claim 29 of 5,335,277 only in that the "instructions" fo the patent claim would be code; claims 7-9 are obvious over claim 3 of 4,704,725 because any station could be controlled; claims 10, 12 - 14 and 16 - 27 are obvious over claim 25 of 4,965,825 and claim 21 of 5,109,414 and claim 15 is obvious over claim 6 of 5,233,654.

#### ***DOUBLE PATENTING BETWEEN APPLICATIONS***

6. Conflicts exist between claims of the following related co-pending applications which includes the present application:

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| #  | Ser. No. | #  | Ser. No. | #  | Ser. No. |
|----|----------|----|----------|----|----------|
| 1  | 397371   | 2  | 397582   | 3  | 397636   |
| 4  | 435757   | 5  | 435758   | 6  | 437044   |
| 7  | 437045   | 8  | 437629   | 9  | 437635   |
| 10 | 437791   | 11 | 437819   | 12 | 437864   |
| 13 | 437887   | 14 | 437937   | 15 | 438011   |
| 16 | 438206   | 17 | 438216   | 18 | 438659   |
| 19 | 439668   | 20 | 439670   | 21 | 440657   |
| 22 | 440837   | 23 | 441027   | 24 | 441033   |
| 25 | 441575   | 26 | 441577   | 27 | 441701   |
| 28 | 441749   | 29 | 441821   | 30 | 441880   |
| 31 | 441942   | 32 | 441996   | 33 | 442165   |
| 34 | 442327   | 35 | 442335   | 36 | 442369   |
| 37 | 442383   | 38 | 442505   | 39 | 442507   |
| 40 | 444643   | 41 | 444756   | 42 | 444757   |
| 43 | 444758   | 44 | 444781   | 45 | 444786   |
| 46 | 444787   | 47 | 444788   | 48 | 444887   |
| 49 | 445045   | 50 | 445054   | 51 | 445290   |

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|-----|--------|-----|--------|-----|--------|
| 52  | 445294 | 53  | 445296 | 54  | 445328 |
| 55  | 446123 | 56  | 446124 | 57  | 446429 |
| 58  | 446430 | 59  | 446431 | 60  | 446432 |
| 61  | 446494 | 62  | 446553 | 63  | 446579 |
| 64  | 447380 | 65  | 447414 | 66  | 447415 |
| 67  | 447416 | 68  | 447446 | 69  | 447447 |
| 70  | 447448 | 71  | 447449 | 72  | 447496 |
| 73  | 447502 | 74  | 447529 | 75  | 447611 |
| 76  | 447621 | 77  | 447679 | 78  | 447711 |
| 79  | 447712 | 80  | 447724 | 81  | 447726 |
| 82  | 447826 | 83  | 447908 | 84  | 447938 |
| 85  | 447974 | 86  | 447977 | 87  | 448099 |
| 88  | 448116 | 89  | 448141 | 90  | 448143 |
| 91  | 448175 | 92  | 448251 | 93  | 448309 |
| 94  | 448326 | 95  | 448643 | 96  | 448644 |
| 97  | 448662 | 98  | 448667 | 99  | 448794 |
| 100 | 448810 | 101 | 448833 | 102 | 448915 |
| 103 | 448916 | 104 | 448917 | 105 | 448976 |
| 106 | 448977 | 107 | 448978 | 108 | 448979 |
| 109 | 449097 | 110 | 449110 | 111 | 449248 |

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|-----|--------|-----|--------|-----|--------|
| 112 | 449263 | 113 | 449281 | 114 | 449291 |
| 115 | 449302 | 116 | 449351 | 117 | 449369 |
| 118 | 449411 | 119 | 449413 | 120 | 449523 |
| 121 | 449530 | 122 | 449531 | 123 | 449532 |
| 124 | 449652 | 125 | 449697 | 126 | 449702 |
| 127 | 449717 | 128 | 449718 | 129 | 449798 |
| 130 | 449800 | 131 | 449829 | 132 | 449867 |
| 133 | 449901 | 134 | 450680 | 135 | 451203 |
| 136 | 451377 | 137 | 451496 | 138 | 451746 |
| 139 | 452395 | 140 | 458566 | 141 | 458699 |
| 142 | 458760 | 143 | 459216 | 144 | 459217 |
| 145 | 459218 | 146 | 459506 | 147 | 459507 |
| 148 | 459521 | 149 | 459522 | 150 | 459788 |
| 151 | 460043 | 152 | 460081 | 153 | 460085 |
| 154 | 460120 | 155 | 460187 | 156 | 460240 |
| 157 | 460256 | 158 | 460274 | 159 | 460387 |
| 160 | 460394 | 161 | 460401 | 162 | 460556 |
| 163 | 460557 | 164 | 460591 | 165 | 460592 |
| 166 | 460634 | 167 | 460642 | 168 | 460668 |
| 169 | 460677 | 170 | 460711 | 171 | 460713 |

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|-----|--------|-----|--------|-----|--------|
| 172 | 460743 | 173 | 460765 | 174 | 460766 |
| 175 | 460770 | 176 | 460793 | 177 | 460817 |
| 178 | 466887 | 179 | 466888 | 180 | 466890 |
| 181 | 466894 | 182 | 467045 | 183 | 467904 |
| 184 | 468044 | 185 | 468323 | 186 | 468324 |
| 187 | 468641 | 188 | 468736 | 189 | 468994 |
| 190 | 469056 | 191 | 469059 | 192 | 469078 |
| 193 | 469103 | 194 | 469106 | 195 | 469107 |
| 196 | 469108 | 197 | 469109 | 198 | 469355 |
| 199 | 469496 | 200 | 469517 | 201 | 469612 |
| 202 | 469623 | 203 | 469624 | 204 | 469626 |
| 205 | 470051 | 206 | 470052 | 207 | 470053 |
| 208 | 470054 | 209 | 470236 | 210 | 470447 |
| 211 | 470448 | 212 | 470476 | 213 | 470570 |
| 214 | 470571 | 215 | 471024 | 216 | 471191 |
| 217 | 471238 | 218 | 471239 | 219 | 471240 |
| 220 | 472066 | 221 | 472399 | 222 | 472462 |
| 223 | 472980 | 224 | 473213 | 225 | 473224 |
| 226 | 473484 | 227 | 473927 | 228 | 473996 |
| 229 | 473997 | 230 | 473998 | 231 | 473999 |
| 232 | 474119 | 233 | 474139 | 234 | 474145 |
| 235 | 474146 | 236 | 474147 | 237 | 474496 |

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|-----|--------|-----|--------|-----|--------|
| 238 | 474674 | 239 | 474963 | 240 | 474964 |
| 241 | 475341 | 242 | 475342 | 243 | 477547 |
| 244 | 477564 | 245 | 477570 | 246 | 477660 |
| 247 | 477711 | 248 | 477712 | 249 | 477805 |
| 250 | 477955 | 251 | 478044 | 252 | 478107 |
| 253 | 478544 | 254 | 478633 | 255 | 478767 |
| 256 | 478794 | 257 | 478858 | 258 | 478864 |
| 259 | 478908 | 260 | 479042 | 261 | 479215 |
| 262 | 479216 | 263 | 479217 | 264 | 479374 |
| 265 | 479375 | 266 | 479414 | 267 | 479523 |
| 268 | 479524 | 269 | 479667 | 270 | 480059 |
| 271 | 480060 | 272 | 480383 | 273 | 480392 |
| 274 | 480740 | 275 | 481074 | 276 | 482573 |
| 277 | 482574 | 278 | 482857 | 279 | 483054 |
| 280 | 483169 | 281 | 483174 | 282 | 483269 |
| 283 | 483980 | 284 | 484275 | 285 | 484276 |
| 286 | 484858 | 287 | 484865 | 288 | 485282 |
| 289 | 485283 | 290 | 485507 | 291 | 485775 |
| 292 | 486258 | 293 | 486259 | 294 | 486265 |
| 295 | 486266 | 296 | 486297 | 297 | 487155 |
| 298 | 487397 | 299 | 487408 | 300 | 487410 |
| 301 | 487411 | 302 | 487428 | 303 | 487506 |

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|-----|--------|-----|--------|-----|--------|
| 304 | 487516 | 305 | 487526 | 306 | 487536 |
| 307 | 487546 | 308 | 487556 | 309 | 487565 |
| 310 | 487649 | 311 | 487851 | 312 | 487895 |
| 313 | 487980 | 314 | 487981 | 315 | 487982 |
| 316 | 487984 | 317 | 488032 | 318 | 488058 |
| 319 | 488378 | 320 | 488383 | 321 | 488436 |
| 322 | 488438 | 323 | 488439 | 324 | 488619 |
| 325 | 488620 | 326 | 498002 | 327 | 511491 |
| 328 | 485773 | 329 | 113329 |     |        |

7. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. The attached Appendix provides clear evidence that such conflicting claims exist between the 329 related co-pending applications identified above. However, an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

In order to resolve the conflict between applications, applicant is required to either:

- (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 329 applications, or;
- (2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant

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should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;

(3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in abandonment of the application.

#### ***INFORMATION DISCLOSURE STATEMENTS***

8. Receipt is acknowledged of applicant's Information Disclosure Statements filed December 4, 1995, December 22, 1995, February 6, 1996 and April 7, 1997. In view of the unusually large number of references cited in the instant application (approximately 2,200 originally and 645 in the subsequent IDS) and the failure of applicant to point out why such a large number of references is warranted, these references have been considered in accordance with 37 C.F.R. 1.97 and 1.98 to the best ability by the examiner with the time and resources available.

The foreign language references cited therein where there is no statement of relevance or no translation are not in compliance with 37 C.F.R. 1.98 and have not been considered. Numerous references listed in the IDS are subsequent to applicant's latest effective filing date of 9/11/87, therefore, the relevancy of these references is unclear. Also cited are numerous references that are apparently unrelated to the subject matter of the instant invention such as: US

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Patent # 33,189 directed toward a beehive, GB 1565319 directed toward a chemical compound, a cover sheet with only the word "ZING", a computer printout from a library search with the words "LST" on it and a page of business cards including that of co-inventor James Cuddihy, among others. The relevancy of these references cannot be ascertained. Furthermore, there are several database search results listed in foreign languages (such as German) which list only the title and document information; no copy has been provided, therefore, these references have not been considered.

***CLAIM REJECTIONS - 35 USC § 112***

9. Claims 2-10 and 12 - 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

**37 C.F.R. 1.75(d)(1) requires that:**

"the terms and the phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description".

The following limitations were not supported by the specification as originally filed:

In claims 2, 7,10 and 15, the financial analysis, in claim 3, the target processor and the digital television of claim 26.

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***CLAIM REJECTIONS - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

11. Claim 2 is rejected under 35 U.S.C. 102 a as being anticipated by WO81/02961(newly cited). WO81/02961 (Campbell) was published on October 15, 1981, before the date of November 3, 1981 argued by applicant's on page 13 of the August 12, 1997 response. The arguments on pages 24 and 25 of the response are noted. In Figure 17 Campbell has both tier and program enabled codes that represent financial data as to payment for services. The control signal is extracted from the vertical interval. Campbell thus has the claimed financial analysis and control signal.

***CLAIM REJECTIONS - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 3 - 10 and 12 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell (WO 81/02961) in view of Hedger et al. The arguments on pages 25 -28 of the August 12, 1997 response have been thouroughly rewievd. On page 25 applicants argue that there must be some suggestion to combine in the references. If this requirement were true there would be no need for 35 U. S. C. 103 as then the reference with the suggestion to combine would be anticipatory. Campbell has the financial analysis and Hedger the downloadable code. Campbell certinly has a signal, equivalent to the "instruct" signal that causes steps 322, 324 or 330 to be executed.the claimed transmitter is shown in Figure 2 of Campbell. The dependent claims are obvious as in the previous office action. The new claims are obvious because any signal can be imbedded in a higher bandwidth signal and Campbell has viewer reaction.

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